



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIN 04-04

STEPHEN C. GLAZIER
KIRKPATRICK & LOCKHART LLP
1800 MASSACHUSETTS AVENUE, NW
WASHINGTON DC 20036

COPY MAILED

APR 16 2004

OFFICE OF PETITIONS

In re Application of :
Hellbusch, Propst, Balsavar, :
Schaefer, and Wardhan : DECISION REFUSING STATUS
Application No. 10/696,163 : UNDER 37 CFR 1.47(a)
Filed: 29 October, 2003 :
Atty Dkt No. 0307091.0169 :
:

This is in response to the petition filed under 37 CFR 1.47(a)¹ on 25 February, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 29 October, 2003, with a declaration naming Mark H. Hellbusch, Bryon K. Propst, Girish U. Balsavar, Robert G. Schaefer, and Harsh Wardhan as joint inventors and signed by all inventors except Wardhan on behalf of themselves and joint inventor Wardhan. Accordingly, on 22 December, 2003, Initial Patent Examination Division mailed a Notice to File Missing Parts of Application, requiring Wardhan's signature on the oath or declaration and a surcharge for its late filing. A two (2)-month period for reply was set.

¹A petition under 37 CFR 1.47(b) is inappropriate in this instance since one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign. Accordingly, the petition will be treated as a petition under 37 CFR 1.47(a).

BEST AVAILABLE COPY

In response, on 25 February, 2004, petitioners filed the present petition.

Petitioners state that a copy of the application was sent to Wardhan (a.k.a. Harsh Gupta) by e-mail (copy attached) but that the non-signing inventors' current employer, but that the inventor has not signed the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

With regard to item (1), while petitioners have provided a copy of an E-mail transmitting the application to Harsh Gupta, on 20 February, 2004, the petition was filed only 5 days later. As such, there is a question whether the non-signing inventor was given sufficient time to review the application papers and sign and return the declaration. Additionally, as the E-mail was sent to "Harsh Gupta", and the inventor has not provided documentary evidence of a legal change of name, it is unclear whether the E-mail constitutes a valid presentment under Rule 47. Therefore, in the absence of evidence of a legal change of name, it is recommended that petitioners send a copy of the application papers (specification, including the claims, drawings if any, and the declaration) to the named inventor (Harsh Wardhan) at his last known address.

Petitioners must show proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) were sent or given to the non-signing inventor for review.² Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor

²MPEP 409.03(d).

or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Petitioners must also present proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

It is additionally noted that if petitioners wish to have Wardhan's name changed in Office records, a petition under 37 CFR 1.182 for change of inventor's name, accompanied by the appropriate petition fee, must be filed.

With regard to item (2), the declaration present with the present petition is defective in that it lacks the residence and mailing address of non-signing inventor Wardhan. The oath or declaration must identify the mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor.³ Petitioners must submit a new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventor. Further correspondence with respect to this matter should be addressed as follows:

Since this petition was not filed within two (2) months of the date that the Notice to File Missing Parts was Mailed, a \$110.00 one (1) month extension of time fee is due and will be charged to counsel's deposit account, No. 50-1721.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

BEST AVAILABLE COPY

³37 CFR 1.63(c).

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

BEST AVAILABLE COPY